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OFFICE OF PETITIONS

In re Application of	:	
Chamberlain	:	
Application No. 10/788,637	:	DECISION
Filing Date: 27 February, 2004	:	
Attorney Docket No. 75-2	:	

This is a decision on the petition filed on 29 March, 2005, to revive the instant application under 37 C.F.R. §1.137(a) as having been abandoned due to unavoidable delay, and in light of the allegations considered alternatively as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition:

- under 37 C.F.R. §1.137(a) is **DISMISSED**; and
- as considered under 37 C.F.R. §1.181 is **DISMISSED**.

NOTES:

- (1) Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)."

(It is noted, however, that Petitioner may be unable to present a satisfactory

showing to support a petition under 37 C.F.R. §1.137(a), and Petitioner's only alternative will be to file a petition under 37 C.F.R. §1.137(b).)

- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the Notice to File Missing Parts mailed on 24 May, 2004, with reply due absent extension of time on or before Monday, 26 July, 2004;
- the application went abandoned after midnight 24 July, 2004;
- the Office mailed the Notice of Abandonment on 11 February, 2005;
- Petitioner filed the instant petition (with fee), made a statement alleging non-receipt of the Notice to File Missing Parts (a copy of which is enclosed herewith) but provided no documentation in support of that statement (e.g., mail logs, docket sheets evidencing no response due on or before 26 July, 2004, etc.), and filed no reply to the Notice of Missing Parts.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for

¹ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

the reply now to be accepted on petition.²

Delays in responding properly raise the question whether delays are unavoidable.³ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴ And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶))

As to a Request to Withdraw
the Holding of Abandonment

Petitioner alleges non-receipt—and so prompts consideration as a request withdrawal of the holding of abandonment under 37 C.F.R. §1.181—but provides no documentation in support of the allegation.

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁷ (See: the commentary set forth at MPEP §711.03(c).)

Thus, Petitioner also fails to satisfy the showing required under Delgar and thus to be considered under the provisions of 37 C.F.R. §1.181.

As to Allegations
of Unavoidable Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

³ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁴ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁵ See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁷ See: *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971).

showing of unavoidable delay, a proper reply, and--where appropriate--a terminal disclaimer and fee if the application was filed before 8 June, 1995.

Petitioner has failed to satisfy the "showing" and "reply" requirements as to a petition under 37 C.F.R. §1.137(a).

CONCLUSION

The petition:

- under 37 C.F.R. §1.137(a) is **dismissed** and the petition fee (\$500.00) is charged as authorized to Deposit Account 50-1713; and
- as considered under 37 C.F.R. §1.181 is **dismissed**.

ALTERNATIVE VENUE

Petitioner's inability make a showing to support the instant petition leaves as Petitioner's only alternative to irretrievable abandonment a petition alleging unintentional delay under 37 C.F.R. §1.137(b).⁸

Therefore, Petitioner may wish to consider filing a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay.

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply (the RCE, fee, and submission), the petition fee, and a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional."

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

⁸ The regulations at 37 C.F.R. §1.183 sets forth that waiver of the rules is "subject to such other requirements as may be imposed."

By FAX: IFW Formal Filings
(703) 872-9306
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to be "John J. Gillon, Jr.", with a large, stylized loop at the end.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

Encl: Notice of Missing Parts (24 May, 2004)